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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,659	12/06/2001	Reid Burton Kowallis	ABI-0042	1348

7590

09/09/2004

Woodcock Washburn LLP  
46th Floor  
One Liberty Place  
Philadelphia, PA 19103

EXAMINER
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ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/010,659

Applicant(s)

KOWALLIS ET AL.

Examiner

Lyle A Alexander

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/29/02.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-13 and 16-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hautea et al. (USP 5,460,783) or Gordon et al. (5,540,889).

Hautea et al. teach a microtiter plate(30) with exterior wall surfaces, a plate handling machine having a plate support surface(20) and sample-handling device(120) which operates on individual wells(32), a controller(150,160) for controlling the position of the sample handling device and locator structures(22) disposed on the plate support surface for engaging exterior wall surfaces of one or more wells so as to fix the position of the wells in a known location with respect to defined coordinates. Additionally, wherein the locator structure engages the exterior wall of at least one but no more than four adjacent wells (col. 3-6, Figs. 1, 2A-3B). The at least one projection(22) from a central cavity or well(24) which due to the tapered projections define an opening which extends away from the plate support surface(20).

Gordon et al. teach a microtiter plate with exterior walls surface, a plate handling machine having a plate support surface(50) and sample handling device(12) which operates on individual wells, a controller(18) for controlling the position of the acting

member support(10) and a locator structure(52) disposed on the acting member support for engaging interior wall surfaces of one or more wells(56) of the place support.

***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-6 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hautea et al. or Gordon et al. in view of Bevirt et al. (USP 6,063,579).

See Hautea et al. and Gordon et al. supra.

Hautea et al. and Gordon et al. do not teach a biasing assembly operable to urge the exterior wall surfaces of the locator structure together when the microtiter plate is

positioned on the plate support surface. However, Bevirt et al. teach a microtiter plate(50,70) with exterior wall surfaces, a plate handling machine having a plate support surface(52,76) and at least two locator structures(24,60,78) disposed on the plate support surface for engaging exterior wall surfaces of one or more wells so as to fix the position of the well in a known location with respect to defined coordinates and biasing assembly positioned on the plate support surface which includes a vacuum source(160) in columns 3-4 and Figs. 4-6.

It would have been obvious to one of ordinary skill in the art to have included in the apparatus of Hautea et al. or Gordon et al. the biasing assembly of Bevirt et al. One of ordinary skill in the art would have recognized the use of such a biasing means to draw the microtiter plate against the plate support surface and locator structure would correct any nonuniformity of the work surface of the plate such that transfer of material to and from the plate in a automated format can be made more consistent and complete (col. 2, lines 24-33).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander  
Primary Examiner  
Art Unit 1743

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